



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

JK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,495	12/30/2003	Charles R. Roe	10347/20019	8734
7590	11/15/2004		EXAMINER	
Eugenia S. Hansen Sidley Austin Brown & Wood LLP Suite 3400 717 North Harwood St. Dallas, TX 75201			WEDDINGTON, KEVIN E	
			ART UNIT	PAPER NUMBER
			1614	
DATE MAILED: 11/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/748,495	ROE, CHARLES R.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kevin E. Weddington	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 12 April 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 17-52 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 17-52 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

The allowance of claims 17-52 is removed so that a new rejection can be made by the request of the TC 1600 Quality Assurance Team.

Claims 17-52 are presented for examination.

Applicant's preliminary amendment filed May 21, 2004 has been received and entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are directed to a method of treating a patient in need of treatment for a cardiac disorder, comprising administering an effective amount of a seven-carbon fatty acid.

Attention is directed to In re Wands, 8 USPQ2d 1400, 1401 (CAFA, 1988) where set forth factors to consider when assessing whether or not a disclosure would require undue experimentation. These factors are:

- 1) the quantity of experimentation necessary
- 2) the amount of direction or guidance provided

- 3) the presence or absence of working examples
- 4) the nature of the invention
- 5) the state of the art
- 6) the relative skill of those in the art
- 7) the predictability of the art and
- 8) the breadth of the claims.

The instant specification fails to provide guidance that would allow the skilled artisan background sufficient to practice the instant invention without resorting to undue experimentation in view of further discussion below.

The nature of the invention, state of the prior art, relative skill of those in the art and the predictability of the art

The claimed invention related to a method of treating a patient with a cardiac disorder comprising administering an effective amount of a seven-carbon fatty acid composition.

The relative skill of those in the art is generally that of a Ph. D. or M.D.

The broad recitation of claims drawn to a genus of compounds comprising seven-carbon fatty acid chains with any and all substitutions, as long as the substitution is not carbon. There is no additional compounds disclosed and no adequate written description of the genus as broadly claimed.

The breadth of the claims

The claims are broadly drawn to treating any patient with any cardiac disorder.

The amount of direction or guidance provided and the presence or absence of working examples

The working examples are limited to an in vitro cell culture assay of cells derived from a deceased infant, a single cell culture derived from a fetus, and a single in vivo example of treating an infant with triheptanoin-supplemented formula.

No working examples or guidance as to how to make or administer compounds other than the recited species of claim 22. No working examples commensurate in scope with the broadly claimed invention drawn to treating any patient with any cardiac disorder. Furthermore, the no working examples on how to exemplify a method for directly providing fuel to the heart tissue of a patient (claim 47).

The quantity of experimentation necessary

Applicants have failed to provide guidance as which particular seven-carbon fatty acid will treat a patient with any cardiac disorder or the providing fuel to the heart tissue of the patient. Even for the data presented, not direction is provided to treat a patient suffering from any cardiac disorder with other compounds besides those of claim 22. With regard to the quantity of experimentation needed to make or use the invention based on the content of the disclosure, the level of experimentation needed based on the unpredictable nature of the invention and the extreme breadth of the claims, one skilled in the art could not use the claimed invention without undue experimentation.

Claims 17-52 are not allowed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 42 recited a method of treating a patient with a cardiac disorder by administering an effective amount of a seven-carbon fatty acid chain composition to provide relief. The claims do not recite the parameters of what an effective amount is or how the relief is to be measured. The remaining claims 18-41 and 43-46 are rendered indefinite to the extent that they incorporate the above terminology.

Claims 17-46 are not allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571)272-0587. The examiner can normally be reached on 11:00 am-7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0953. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*KE - Weddington*  
Kevin E. Weddington  
Primary Examiner  
Art Unit 1614

K. Weddington  
November 11, 2004